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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,397	08/30/2001	Aaron S. Witt	D/A1466	8229

7590 10/19/2004

Patent Documentation Center
Xerox Corporation
Xerox Square 20th Floor
100 Clinton Ave. S.
Rochester, NY 14644

EXAMINER

HO, THE T

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,397

Applicant(s)

WITT ET AL.

Examiner

The Thanh Ho

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/30/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the application filed 8/30/2001.
2. Claims 1-16 have been examined and are pending in the application.

Claim Objections

3. Claim 8 is objected to because of the following informalities: the word "ona" should be written as "on a" (line 3 claim 8). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following terms lack antecedent basis:

(i) "the destination port" (line 7 claim 1). Correction is required.

(ii) "the activating means" (lines 2-3 claim 11; line 1 claim 12). Corrections are required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lo U.S Patent No. 5,911,044.

As to claim 10, Lo teaches a driver (virtual twain driver 106, Fig. 3) for use in a computer (client 102, Fig. 3) adapted to accept image data over a network (...a network scanning system which allows an application program running on a client computer to control and receive information from an image scanner over a computer network, in a manner which is similar to having the scanner directly connected to the client computer..., lines 11-16 column 2), the computer comprising a port (image being sent to port 108 of client 102, Fig. 3) and means for directing image data received at the port to a target location in memory (...the resulting image file is transferred over the network 120 through the client protocol encoder/decoder to the file catcher 112 which writes the file into a storage device 110..., lines 10-13 column 8), the driver comprising:

means for polling the target location in memory (client computer can access image file stored locally in the client computer, lines 28-30 column 3);

Art Unit: 2126

means for initiating an image acquisition program in response to detecting image data in the target location (...referred to as the scan-to-file operation, an image file is transferred to a storage medium of the client computer. The client computer can then access this image file by any type of image processing software..., lines 23-32 column 3).

As to claim 12, Lo further teaches activating an application in response to detecting image data in the target location. (...an application program 104 such as a program which acquires images. The application program may also process the image data which is acquired..., lines 43-45 column 6).

As to claim 13, Lo further teaches a list of network addresses of approved external devices (a list of available network scanner servers, line 4 column 15).

As to claim 14, Lo further teaches comparing a network address received at the port to the list of approved network addresses (...register the client computer with the scanner server. In this manner, the client computer will only accept the commands and accompanying data from the scanner server after the client computer has performed a registration process with the scanner server..., lines 6-15 column 3).

As to claim 15, Lo further teaches allowing image data to be sent to the target location if the network address received at the port is on the list of approved network addresses (...has the requests and commands initiated at or by the client computer 102. Therefore, unless the client computer 102 initiates an operation or registers with the scanner server 130, the scanner server 130 does

Art Unit: 2126

not have access and cannot store data in or write data to the client computer 102..., lines 21-28 column 7).

As to claim 16, Lo further teaches indicating that a network address received at the pod is not on the list of approved network addresses (the scanner server 130 does not have access and cannot store data in or write data to the client computer 102..., lines 21-28 column 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lo in view of Microsoft PressPass 1999 publication.

As to claim 11, Lo further teaches sending an image scanned event signal (scanning operation begin in step 454 utilizing the acquire command, Fig. 8A). Lo does not explicitly teach the image acquisition program is Microsoft Windows Image Acquisition Scanner and Camera Wizard. Microsoft PressPass teaches the use of Microsoft Windows Image Acquisition Scanner and Camera Wizard as the image acquisition program for capturing, viewing, manipulating and publishing still images (first discussion paragraph page 1). It would have

Art Unit: 2126

been obvious to apply the teachings of Microsoft PressPass to the system of Lo because the use of Microsoft Windows Image Acquisition Scanner and Camera Wizard as the image acquisition program is well known in the art is disclosed by Microsoft PressPass.

7. Claims 1-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih U.S Patent No. 6,798,545 in view of Lo.

As to claim 1, Shih teaches a method of scanning a document (Fig. 4), comprising:

recording, at a scanner, the document to yield digital image data (...the scanning module 46 scan a document 48 and generate associate document image signals..., lines 66-67 column 2);

entering destination information relating to a destination computer to which the digital image data is desired to be sent (using the touch-sensitive panel of the scanner to enter the email address of the destination or personal computer where the image should be sent to, lines 39-64 column 3, lines 32-41 column 4);

sending the image data to the destination computer (...the document image signals are transmitted across the network in an electronic mail format to the device 64; the electronic device 64 could be a personal computer, the application program 80 being a document scan processing program, and the document image signals are transmitted to the personal computer through the communication circuit control program 78..., lines 50-64 column 3). Shih does

Art Unit: 2126

not explicitly teach the destination computer initiating an image acquisition program in response to detecting the image data at a destination port.

Lo teaches a system of scanning image wherein the image is also being sent directly from the scanner to the destination computer (...a network scanning system which allows an application program running on a client computer to control and receive information from an image scanner over a computer network, in a manner which is similar to having the scanner directly connected to the client computer..., lines 11-16 column 2) wherein the destination computer (client 102, Fig. 3) initiating an image acquisition program (...an application program 104 such as a program which acquires images. The application program may also process the image data which is acquired..., lines 43-45 column 6) in response to detecting the image data at a destination port (image being sent to port 108 of client 102, Fig. 3). It would have been obvious to apply the teachings of Lo to the system of Shih because the user can use the image in its running application as disclosed by Lo (lines 41-65 column 6).

As to claim 2, Shih as modified further teaches entering destination file information relating to a destination file in the destination computer to which the digital image data is desired to be sent (using the touch-sensitive panel of the scanner to enter the email address of the destination or personal computer where the image should be sent to, lines 39-64 column 3, lines 32-41 column 4).

As to claim 3, Shih as modified further teaches the sending step having no intermediate computer associated therewith (scanning image being sent directly from the scanner to the personal computer, lines 50-64 column 3).

As to claim 4, Lo further teaches the destination computer performs no polling through a port to detect image data (lines 3-20 column 8).

As to claim 5, Shih as modified further teaches the entering step occurring at the scanner (using the touch-sensitive panel of the scanner to enter the email address of the destination or personal computer where the image should be sent to, lines 39-64 column 3, lines 32-41 column 4).

As to claim 6, Lo further teaches the destination computer initiating an image management program in response to detecting the image data at the destination port (...an application program 104 such as a program which acquires images. The application program may also process the image data which is acquired..., lines 43-45 column 6).

As to claim 8, it is a method claim of claims 13 and 15. Therefore, it is rejected for the same reasons as claims 13 and 15 above.

As to claim 9, it is a method claim of claims 13 and 16. Therefore, it is rejected for the same reasons as claims 13 and 16 above.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shih in view of Lo, and further in view of Microsoft PressPass 1999 publication.

As to claim 7, Microsoft PressPass further teaches the image acquisition program emulates functions of a digital camera (...capture, view, manipulate and publish still images..., last two lines of first discussion paragraph page 1).

Conclusion

Art Unit: 2126

Any inquiry concerning this communication or earlier communications from the examiner should be directed to The Thanh Ho whose telephone number is (571) 272-3762. A voice mail service is also available for this number. The examiner can normally be reached on Monday – Friday, 8:30 am – 5:00 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Any response to this action should be mailed to:

Commissioner for Patents


P.O Box 1450

Alexandria, VA 22313-1450

Or fax to:

- AFTER-FINAL faxes must be signed and sent to (703) 872 - 9306.
- OFFICAL faxes must be signed and sent to (703) 872 - 9306.
- NON OFFICAL faxes should not be signed, please send to (571) 273 – 3762

TTH
October 14, 2004


MENG-AL T. AN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100